

REMARKS/ARGUMENTS

Claims 1-4 are pending in the subject application. Claim 1 has been amended. No new claims have been added.

Rejections under 35 U.S.C. §112, 2nd paragraph

Claims 1-4 have been rejected under 35 U.S.C. §112, 2nd paragraph as allegedly being indefinite for including the term “or” in the Markush grouping. Claim 1, the only claim in which the term “or” is used in a Markush group, has been amended. The Markush group as amended, in addition to specifying certain oils (as discussed below in the response to the rejections under 35 U.S.C. §102), uses the conjunctive terminology “and”. It is respectfully submitted that the Examiner’s objections are obviated by this amendment. Reconsideration and withdrawal of this ground of rejection is, therefore, respectfully requested.

The Examiner also indicated that claim 3 is confusing in that it was uncertain whether the “sugar content” refers to the initial amount of sugar or whether the amount is maintained through the culturing process. The “sugar content” refers to the initial amount of the sugar provided to the culture medium. Discussion of the “sugar content” can be found in the subject specification in the paragraphs bridging pp. 5-6. Applicants respectfully submit that claim 3 is, therefore, not indefinite as the metes and bounds of this claim would be readily understood by a person having ordinary skill in the art, in light of the specification. Reconsideration and withdrawal of this aspect of the indefiniteness rejection is, therefore, respectfully requested.

Rejections under 35 U.S.C. §102

Claims 1-4 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Chambon *et al.* (“Chambon”) and under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,410,755 to Millis *et al.* (“Millis”). It is noted that Millis *et al.* issued on June 25, 2002, which is after the December 28, 2001 United States filing date of the subject application. Therefore, Millis is available as a reference only under 35 U.S.C. §102(e), based on its U.S. filing date of July 6, 1999.

The rejections over Chambon and Millis are respectfully traversed. The Examiner asserts that the claims are anticipated because each of Chambon and Millis discloses production of prenyl alcohols such as farnesol by culturing a strain of *Saccharomyces* in the presence of the lipid ergosterol in a medium containing 2-7% sugar. The Examiner maintains that ergosterol is a "fat or oil," and thus reads on this recitation in claim 1, prior to the present amendment.

Claim 1 has been amended to delete "fat or oil" and replace that recitation with a member selected from the group consisting of "soybean oil, fish oil, almond oil and olive oil." Neither Chambon nor Millis discloses use of any of these oils. Indeed, ergosterol is a sterol, quite distinct from the oils now recited in claim 1, as amended. The effect of using such oils in the production of prenyl alcohol is shown in the Examples in the subject specification. The effect of using such oils is not taught or suggested by the prior art.

Accordingly, it is respectfully submitted that neither Chambon nor Millis anticipates or renders obvious claim 1 as amended. Reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) over each of Chambon and Millis is respectfully requested.

CONCLUSION

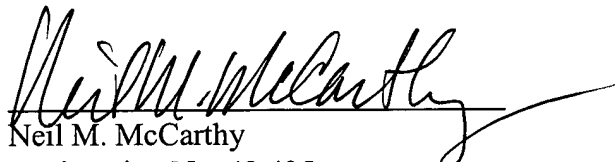
It is submitted that the subject application is now in condition for allowance, which action is earnestly solicited. The Examiner is invited to contact Applicants' representative, at the number below, to discuss any matter that would expedite allowance.

Because this response is being submitted within 3 months of the date on the Office Action, is believed that no extension of time fees are required. The Commissioner is, however, authorized to charge Kenyon & Kenyon's Deposit Account No. 11-0600 for any fees deemed necessary, or to credit any overpayment.

Respectfully submitted,

Date:

March 30, 2004


Neil M. McCarthy
Registration No. 43,435

KENYON & KENYON
1500 K Street, N.W., , Suite 700
Washington, DC, 20005
Telephone: 202-220-4200
Facsimile: 202-220-4201
DCO1 488224v1